

REMARKS

Claims 1-22 were pending in this application.

Claims 1 and 2 have been rejected.

Claims 3-12 have been objected to.

Claims 13-22 have been allowed.

No claims have been amended.

Claim 23 has been added.

Claims 1-23 are now pending in this application.

Reconsideration and full allowance of Claims 1-23 are respectfully requested.

I. ALLOWABLE CLAIMS

The Applicants thank the Examiner for the indication that Claims 13-22 are allowable. Claims 13-22 have not been amended and therefore remain in condition for allowance.

The Applicants also thank the Examiner for the indication that Claims 3-12 would be allowable if rewritten in independent form. Because the Applicants believe that the remaining claims in this application are allowable, the Applicants have not rewritten Claims 3-12 in independent form.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,997,122 to Zimmer (“Zimmer”) in view of U.S. Patent No. 4,887,452 to

Bakermans (“*Bakermans*”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references

when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (*MPEP* § 2142).

The Office Action acknowledges that *Zimmer* fails to disclose a "stamping tool" capable of "aligning a position of [a] stamp with respect to at least one tooling hole in [an] integrated circuit substrate" as recited in Claim 1. The Office Action then asserts that *Bakermans* discloses these elements of Claim 1 and that it would be obvious to combine *Zimmer* and *Bakermans*. (*Office Action*, Page 2, Last paragraph).

Bakermans recites a "strip feeding mechanism" intended for use in a stamping and forming machine. (*Abstract*). The machine includes a ram 14 having a tooling 18 and a ram 16 having an opening 20 for receiving the tooling 18. (*Col. 3, Lines 41-50*). Closing the rams 14 and 16 causes the tooling 18 to punch a hole in a strip 2 of material. (*Col. 3, Lines 46-50*). The ram 14 also includes two pilot pins 24, which are inserted through pilot holes 4 in the strip 2 of material and into holes 27 in the ram 16. (*Col. 3, Lines 50-57; Figure 1*).

It is unclear how the Office Action proposes to modify *Zimmer* with the recitations of *Bakermans*. *Zimmer* recites that a tool for shaping solder includes two stops (element 10 in Figure 1, element 122 in Figure 2, element 104 in Figure 4, and element 116 in Figure 7). If the Office Action proposes to modify *Zimmer* so that the stops are inserted through holes in an integrated circuit die, this modification is improper. The whole purpose of the stops in *Zimmer* is to prevent the tool from forming grooves all of the way through the solder being shaped. (*Col. 4, Line 62 – Col. 5, Line 2*). As a result, a person skilled in the art would not be motivated to

modify *Zimmer* so that the stops are inserted through holes in an integrated circuit die.

For these reasons, the Office Action has not established a *prima facie* case of obviousness against Claim 1 (and Claim 2 depending from Claim 1). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1 and 2.

III. NEW CLAIM

The Applicants have added new Claim 23. The Applicants respectfully submit that no new matter has been added. The Applicants respectfully request entry and full allowance of Claim 23.

IV. CONCLUSION

The Applicants assert that all pending claims in this application are in condition for allowance and respectfully request allowance of the claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicants have included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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